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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

200301934-1

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on November 30, 2005

Signature



Typed or printed name Jessica R. Beedle

Application Number

09/965,960

Filed

09/28/2001

First Named Inventor

Michael F. ANGELO et al.

Art Unit

2137

Examiner

M. J. Pyzocha

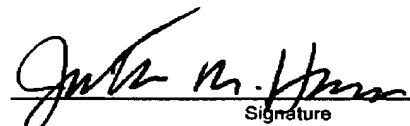
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record. 44,144
Registration number _____ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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November 30, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of one (1) forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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NOV 30 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:	Michael F. ANGELO et al.	§	Confirmation No.:	3303
Serial No.:	09/965,960	§	Group Art Unit:	2137
Filed:	09/28/2001	§	Examiner:	M. J. Pyzocha
For:	After The Fact Protection Of Data In Remote Personal And Wireless Devices	§ § § §	Docket No.:	200301934-1

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
 Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

Date: November 30, 2005

Sir:

Appellants hereby submit this Pre-Appeal Brief Request for Review in connection with the above-identified application. A Notice of Appeal is filed concurrently herewith.

The Examiner used Kenichi in the art rejection of all claims. At the outset, Appellants point out that the Kenichi reference is a Japanese language document that has been translated into English. The quality of the translation is very poor and it is very difficult to determine what Kenichi actually teaches. From the URL provided at the bottom of the page of the Kenichi patent, the translation appears to have originated from the JPO/NCIPI website which provides computer-generated translations and a disclaimer that translations may not be accurate. The disclaimed is that “[t]his document has been translated by computer. So the translation may not reflect the original precisely.” Accordingly, Appellants believe the computer-generated translation of the Kenichi patent should be given little, if any, prior art weight.

At any rate, Kenichi seems to disclose a system by which a user can access an information center 14 to report that a portable radio terminal 11 has

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been stolen and to request that a lock command be transmitted to the stolen terminal 11. Upon receipt of the lock command, the terminal erases "all of the contents" of a random access memory (RAM). See e.g., Abstract of Kenichi.

Claim 1 requires (reference letters A-E have been added for clarity in this brief) "performing an action on said portable electronic device in response to said security message, said action selected from a group consisting of (A) causing a short circuit, (B) placing the portable electronic device in a mode in which a function of the portable electronic device is disabled, (C) operating memory at an incorrect clock rate, (D) causing said portable electronic device to report its location, and (E) precluding access to data stored in the portable electronic device." Kenichi does not disclose or even teach any of the listed actions recited in claim 1. The Examiner stated in the final Office action (page 11) that Kenichi discloses the action of precluding access to data stored in the portable device which is the last listed alternative action (E) in the Markush grouping. In making this statement and not arguing that any of the other actions listed in the Markush grouping are taught by Kenichi, the Examiner has apparently concluded, and Appellants would agree, that Kenichi does not teach any of actions (A) through (D).

As for action (E) ("precluding access to data stored in the portable electronic device"), the Examiner turned to the Abstract and paragraph 22 of Kenichi. The Abstract states that "all the contents of an owner's personal data storage RAM" are erased. If all of the data is erased, then clearly there is no data remaining on the device. If no data remains on the device, then the Kenichi system logically cannot be said to preclude access to such non-existent data. Alternatively stated, a portable electronic device cannot preclude access to "data stored in the portable electronic device" if there is no data to which to preclude access. At the risk of being overly redundant, precluding access to data requires there to be data to preclude access to. For at least this reason, claim 1 and all claims dependent thereon are patentable.

Some claims dependent from claim 1, for example, claims 5-9 and 12, include various aspects of encryption, digital signatures, and the like. For

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example, claim 5 states that the method comprises "digitally signing said security message." The Examiner recognized that Kenichi is deficient in this regard and, instead, turned to Menezes. Menezes, however, is simply a handbook on the general topic cryptography.

The Federal Circuit has made clear that "[i]t is impermissible to use the claimed invention as an instruction manual...to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (reversing the examiner's rejection on this basis). Federal Circuit case law strongly admonishes against piecing together the prior art by using an applicant's teachings in hindsight. This is so because it is well known that most, if not all, inventions are combinations of known limitations. *Interconnect Planning Corp. v. Feil*, 774 F.2nd 1132, 1143 (Fed. Cir. 1985) ("35 U.S.C. § 103 requires that obviousness be determined with respect to the invention as a whole. This is essential for combination inventions, for generally all combinations are of known elements.").

Of course, the concept of encrypting a piece of data or digitally signing something in and of itself is not new to Appellants. What is new are limitations involving encryption, digital signatures, etc. as recited in claims 5-9 and 12 in combination with the other claim features. The Examiner has done nothing other than establish that encryption, for example, by itself is not new. The Examiner, however, must go beyond that to establish a *prima facie* case of obviousness. With regard to claims 5-7, for example, the Examiner states that it would have been obvious to use Menezes's general explanation of digital signatures to the security message of Kenichi for the purpose of "authentication, authorization, and non-repudiation." Appellants themselves were trying to provide authentication and authorization to the subject matter at hand. Thus, the Examiner has used Appellants' teachings against the Appellants in clear violation of Federal Circuit case law. The Examiner, on page 12 of the final Office action, stated that page 22 of Menezes provides a motivation to combine Menezes with Kenichi. Appellants find no such motivation and the Examiner interestingly did not identify any specific sentence from page 22 of Menezes to support the alleged motivation

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to combine. It is thus improper for the Examiner to use Menezes in combination with Kenichi in rejecting the claims. Claims 5-9 and 12 are allowable for this additional reason as well.

Claim 23 is directed to a portable electronic device that has been amended as shown. Claim 23 is allowable for much the same reason as claim 1 and thus that reasoning is not repeated. All claims dependent from claim 23 are allowable as well at least for the same reasoning as claim 23. Some claims dependent from claim 23 have limitations related to encryption and digital signatures. Such claims were rejected as obvious using Menezes in combination with Kenichi. For the reasoning expressed above, Menezes cannot be used in the rejection of such claims.

Claims 38 and 39 explain that the "decryption key cannot be overwritten" and that the "decryption key cannot be copied." The Examiner apparently did not find these limitations in any art of record, and instead took "Official Notice" that such limitations are well known. Appellants disagree that such limitations are well known and requested the Examiner to support his position. In the final Office action (page 12), the Examiner identified pages 182 and 185 of the Schneier patent. The Schneier patent, of course, has columns, not page numbers, and certainly does not have 180+ pages. Appellants have no idea what the Examiner has in mind in trying to support the basis for the Official Notice and find no such support in Schneier.

Claims 40-43, 45-46, and 48-51 are patentable for much the same reasons discussed above.

Claim 53 is directed to a portable electronic device that requires that the CPU "receives a security message from one of a plurality of entities and selecting a destructive action to be performed in said portable electronic device based on a determination as to which entity sent the security message." None of the art of record has such a teaching. Dependent claims 54-58 each provide a specific example of a "destructive action." Appellants do not find any of these destructive actions in the art of record.

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Method claims 59-64 are patentable for much the same reasons discussed above regarding claims 53-58.

Appellants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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